IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re application of:

	Kolar, Bradley D. et al.	Examiner:	Sterrett, Jonathan G.
Serial No.:	10/665,179	Group Art Unit:	3623
Filed:	September 17, 2003	Docket No.:	33836.03.0004
For:	EDUCATIONAL PRODUCT EVALUATION METHOD AND APPARATUS		

APPEAL BRIEF PURSUANT TO 37 C.F.R. § 41.37

Dear Sir:

Appellants submit a Petition for a one-month Extension of Time and this brief further to

the Notice of Appeal filed September 7, 2010 in the above-identified application ("the

Application").

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I.   Real Party in Interest

Accenture Global Services Limited is the real party in interest in this appeal by virtue an executed assignment from Accenture Global Serivces GmbH of its entire interest dated September 1, 2010.   An assignment from the named Inventors of their entire interest to Accenture Global Services GmbH was recorded on September 17, 2003 in the United States Patent and Trademark Office at Reel 014526, Frame 0246

II.   Related Appeals and Interferences

To Appellants' knowledge, there are no related Appeals or Interferences filed, pending, or decided.

III. Status of Claims

The originally filed Application contained claims 1-46. Claim 47 was subsequently added by amendment. No claims have been canceled. Claims 1, 2, 5, 11, 21, 31, 34, 39 and 43 were amended during prosecution of the instant application. Claims 1-47 are rejected. No claims have been allowed or held allowable, and there are no objections to the claims. A copy of appealed claims 1-47 are attached at Appendix A. Of the pending, appealed claims, claims 1, 5, 21, 31, 34, 39 and 43 are independent.

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IV.   Status of Amendments

A final Office Action was mailed June 7, 2010 (the "Appealed Office Action"). No amendments to the claims have been made subsequent to the Appealed Office Action, and the claims listed in Appendix A reflect the claims as they stood at the time the Appealed Office Action was mailed.

V.   Summary of Claimed Subject Matter

Claim 1 describes a method, implemented by a computer (FIG. 1, element 14; ¶ 0026), in which business goal rule data (FIG. 1, element 16; ¶ 0028) is stored (FIG. 2, block 202; ¶ 0029) in memory (FIG. 1, element 16; ¶ 0026) of the computer, the business goal rule data representing a business organization's goals with respect to employee training (¶¶ 0003, 0069).   An educational product, which may comprise an instructor led face-to-face course, a self-study course or a virtual course (¶ 0056), is analyzed by the computer based on the stored business goal rule data (FIG. 2, block 204; ¶ 0030).   Thereafter, an education product summary (FIG. 3, element 344; ¶ 0039; FIG. 5; ¶¶ 0043-0045) indicating an alignment of the educational product to the business organization's goals with respect to employee training is displayed (FIG. 2, block 208; ¶ 0031) on a display of the computer.

Claim 5 describes a method, implemented by a computer (FIG. 1, element 14; ¶ 0026), in which business goal rule data (FIG. 1, element 16; ¶ 0028) is stored (FIGs. 2 and 4, block 202; ¶ 0029) in memory (FIG. 1, element 16; ¶ 0026) of the computer, the business goal rule data representing a business organization's goals with respect to employee training (¶¶ 0003, 0069). For each of a plurality of education products (¶ 0056), the computer generates (FIG. 4, block 402; ¶ 0040) a plurality of educational product alignment values (¶ 0040; FIG. 3, elements 324, 326 and 334) representing the alignment of each educational product to the business organization's goals with respect to employee training based on a plurality of associated plurality of educational product evaluation category values (¶ 0027; FIG. 1, element 22; ¶ 0032; FIG. 3, element 312; ¶ 0040) and the stored business goal rule data, wherein an educational product evaluation category value represents at least one of tuition, duration, participant rating or a priority of course with a content area (¶ 0027).   The computer generates (FIG. 4, block 404; ¶ 0040), for each education product, an overall business alignment value (¶ 0024; FIG. 3, element

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342; ¶ 0039) based on the plurality of educational product alignment values. The computer also generates (FIG. 4, block 406; ¶ 0041) an educational product summary (FIG. 3, element 344; ¶ 0039; FIG. 5; ¶¶ 0043-0045) containing at least the overall business alignment value for each of the of educational products, wherein said plurality of educational products includes at least one of an instructor led face-to-face course, a self-study course or a virtual course (¶ 0056).

Claim 21 describes a method, implemented by a computer (FIG. 1, element 14; ¶ 0026), in which business goal rule data (FIG. 1, element 16; ¶ 0028) is stored (FIGs. 2 and 4, block 202; ¶ 0029) in memory (FIG. 1, element 16; ¶ 0026) of the computer, the business goal rule data representing a business organization's goals with respect to employee training (¶¶ 0003, 0069). For each of a plurality of education products (¶ 0056), the computer generates (FIG. 4, block 402; ¶ 0040) a plurality of educational product alignment values (¶ 0040; FIG. 3, elements 324, 326 and 334) indicating the alignment of each educational product to the business organization's goals with respect to employee training based on a plurality of associated plurality of educational product evaluation category values (¶ 0027; FIGs. 1 and 3, element 22; ¶¶ 0032, 0040) and the stored business goal rule data, wherein the educational products include educational courses including at least one of an instructor led face-to-face course, a self-study course or a virtual course (¶ 0056). The resulting education product alignment values are stored in memory of the computer. (¶¶ 0055,0059) The computer generates (FIG. 4, block 404; ¶ 0040), for each education product, an overall business alignment value (¶ 0024; FIG. 3, element 342; ¶ 0039) based on the plurality of stored educational product alignment values. The computer also generates (FIG. 4, block 406; ¶ 0041) an educational product summary (FIG. 3, element 344; ¶ 0039; FIG. 5; ¶¶ 0043-0045) containing at least the overall business alignment value for each of the of educational products, wherein the plurality of stored educational product alignment values

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include (¶¶ 0024, 0040) a strategic importance alignment value (FIG. 3, element 324), a cost effectiveness alignment value (FIG. 3, element 326) and an educational product impact alignment value (FIG. 3, element 334). Furthermore, the strategic importance alignment value is based on strategic importance priority level data of an educational content area and on at least course hours for the educational products associated with the educational content area (¶ 0036); the cost effectiveness alignment value is based on at least a number of hours per educational product and a cost of the educational product (¶ 0037); and the educational product impact alignment value is based on at least participant rating data and usage data associated with the educational products (¶ 0038).

Claim 31 describes an education product evaluation apparatus (FIG. 1, element 14) comprising at least one processing device and memory containing executable instructions (¶ 0026). When executed, the instructions cause the at least one processing device to first store business goal rule data (FIG. 1, element 16; ¶ 0028), the business goal rule data representing a business organization's goals with respect to employee training (¶¶ 0003, 0069). Additionally, the instructions, when executed, cause at least one processing device to generate (FIG. 4, block 402; ¶ 0040) at least one educational product alignment value (¶ 0040; FIG. 3, elements 324, 326 and 334) for an educational product (¶ 0056) based on a plurality of educational product evaluation category values (¶ 0027; FIG. 1, element 22; ¶ 0032; FIG. 3, element 312; ¶ 0040) and the stored business goal rule data, wherein the at least one educational product alignment value indicates the alignment of the educational product to the business organization's goals with respect to employee training, wherein the educational product evaluation category values represent at least one of tuition, duration, participant rating or a priority of course with a content

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area (¶ 0027), and wherein the educational product is one of an instructor led face-to-face course, a self-study course or a virtual course (¶ 0056).

Claim 34 describes an education product evaluation apparatus (FIG. 1, element 14) comprising at least one processing device and memory containing executable instructions (¶ 0026). When executed, the instructions cause the at least one processing device to first store business goal rule data (FIG. 1, element 16; ¶ 0028), the business goal rule data representing a business organization's goals with respect to employee training (¶¶ 0003, 0069), and to provide a source of a plurality of educational product evaluation category values (¶ 0027; FIGs. 1 and 3, element 22). The instructions, when executed, further cause the at least one processor to generate (FIG. 4, block 402; ¶ 0040) a plurality of educational product alignment values (¶ 0040; FIG. 3, elements 324, 326 and 334) representing the alignment of each educational product to said business organization's goals with respect to employee training for each of a plurality of educational products (¶ 0056) based on an associated plurality of educational product evaluation category values obtained from the plurality of educational product evaluation category values source and the stored business goal rule data, wherein an educational product evaluation category value represents at least one of tuition, duration, participant rating or a priority of course with a content area (¶ 0027). The instructions, when executed, further cause the at least one processor to generate (FIG. 4, block 404; ¶ 0040), for each educational product of interest, an overall business alignment value (¶ 0024; FIG. 3, element 342; ¶ 0039) based on the plurality of educational product alignment values and to generate (FIG. 4, block 406; ¶ 0041) an educational product summary (FIG. 3, element 344; ¶ 0039; FIG. 5; ¶¶ 0043-0045) containing at least the overall business alignment value for each of the plurality of educational products values that include: a strategic importance alignment value (FIG. 3, element 324), a cost effectiveness

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alignment value (FIG. 3, element 326) and an educational product impact alignment value (FIG. 3, element 334). Furthermore, the strategic importance alignment value is based on a strategic importance priority level data of an educational content area and on at least course hours for the educational products associated with the educational content area (¶ 0036); the cost effectiveness alignment value is based on at least a number of hours per educational product and a cost of the educational product (¶ 0037); and the educational product impact alignment value is based on at least participant rating data and usage data associated with the educational product (¶ 0038), wherein the plurality of educational products includes at least one of an instructor led face-to-face course, a self-study course or a virtual course ¶ 0056).

Claim 39 describes a storage medium comprising memory containing executable instructions (¶ 0026). When executed by at least one processing device (¶ 0026), the instruction cause the at least one processor to first store business goal rule data (FIG. 1, element 16; ¶ 0028), the business goal rule data representing a business organization's goals with respect to employee training (¶¶ 0003, 0069), and to provide a plurality of educational product evaluation category values (¶ 0027; FIGs. 1 and 3, element 22). Furthermore, when executed, the instruction cause the at least one processor to generate (FIG. 4, block 402; ¶ 0040) a plurality of educational product alignment values (¶ 0040; FIG. 3, elements 324, 326 and 334) representing the alignment of each educational product to said business organization's goals with respect to employee training for each of a plurality of educational products based on a plurality of associated plurality of educational product evaluation category values obtained from the plurality of educational product evaluation category values source and the stored business goal rule data, wherein an educational product evaluation category value represents at least one of tuition, duration, participant rating or a priority of course with a content area (¶ 0027). Further still,

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when executed, the instruction cause the at least one processor to generate (FIG. 4, block 404; ¶ 0040), for each educational product, an overall business alignment value (¶ 0024; FIG. 3, element 342; ¶ 0039) based on the plurality of educational product alignment values and to generate (FIG. 4, block 406; ¶ 0041) an educational product summary containing at least the overall business alignment value for each of the plurality of educational products values that include: a strategic importance alignment value (FIG. 3, element 324), a cost effectiveness alignment value (FIG. 3, element 326) and an educational product impact alignment value (FIG. 3, element 334). The strategic importance alignment value is based on strategic importance priority level data of an educational content area and on at least course hours for the educational products associated with the educational content area (¶ 0036); the cost effectiveness alignment value is based on at least a number of hours per educational product and a cost of the educational product (¶ 0037); and the educational product impact alignment value is based on at least participant rating data and usage data associated with the educational product (¶ 0038), wherein said plurality of educational products includes at least one of an instructor led face-to-face course, a self-study course or a virtual course (¶ 0056).

Claim 43 describes an educational product evaluation apparatus (FIG. 1, element 14) comprising a memory (FIG. 1, element 16; ¶ 0026) containing business goal rule data (FIG. 1, element 16; ¶ 0028) and an educational product analyzer (FIG. 1, element 20; ¶ 0028) operatively coupled to the memory. The educational product analyzer, in turn, comprises a strategic importance generator (FIG. 3, element 300; ¶ 0036) operative to generate a strategic importance alignment value (FIG. 3, element 324) based on a plurality of associated strategic alignment category values (FIG. 3, element 314) and the business goal rule data, the business goal rule data representing a business organization's goals with respect to employee training (¶¶

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0003, 0069) and wherein an educational product is at least one of an instructor led face-to-face course, a self-study course or a virtual course (¶ 0056). The educational product analyzer further comprises a cost effectiveness generator (FIG. 3, element 302; ¶ 0037) operative to generate a cost effectiveness alignment value (FIG. 3, element 326) based on associated cost effectiveness category values (FIG. 3, element 316) and based on the business goal rule data. The educational product analyzer further comprises an educational product impact generator (FIG. 3, element 304; ¶ 0038) operative to generate an educational product impact alignment value (FIG. 3, element 334) based on a plurality of associated educational product impact category values and based on the stored business goal rule data. The educational product analyzer further comprises an overall business alignment generator (FIG. 3, element 306; ¶ 0039) operatively coupled to the strategic importance generator, the cost effectiveness generator and the educational product impact generator, and operative to generate, on a per educational product basis, an overall business alignment value (FIG. 3, element 342; ¶ 0039) based on the strategic importance alignment value, the cost effectiveness alignment value and the educational product impact alignment value. Finally, the education product analyzer further comprises a multi-educational product summary generator (FIG. 3, element 310; ¶ 0039), operatively coupled to the overall business alignment generator, and operative to generate an educational product summary (FIG. 3, element 344; ¶ 0039; FIG. 5; ¶¶ 0043-0045) containing at least the overall business alignment value for each of a plurality of educational products of interest and the strategic importance alignment value, the cost effectiveness alignment value and the educational product impact alignment value.

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VI.   Grounds of Rejection to be Reviewed on Appeal

Claims 1-10, 13-20, 31-33 and 43-46 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Lawlis, et al., "A Formal Process for evaluating COTS Software Products", (C) 2001 IEEE, Computer, pp. 58-63 (hereinafter "Lawlis") in view of Mamoukaris et al, "Evaluation of web-based educational systems", 2000, vol. 1, Academy of Business Education, pp. 1-6 (hereinafter "Mamoukaris") and in further view of Brown, "Using computers to deliver training: Which employees learn and why?", Personnel Psychology 2001 (hereinafter "Brown").

Claims 11, 12, 21-30 and 34-42 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Lawlis in view of Mamoukaris and Brown and in further view of Cheryl Murphy, An Evaluation Format For "Open" Software Tools, Computers and Human Behavior, vol. 11, no. 3-4 , pages 619-631, 1995, (hereinafter "Murphy") and Matthew Owen Howard, R. Dale Walker, Patricia Silk Walker, & Richard T. Suchinsky, Alcohol and Drug Education in Schools of Nursing, Journal of Alcohol and Drug Education, vol. 42, issue 3, Spring 1997, at 54, (hereinafter Howard).

Claim 47 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Lawlis in view of Mamoukaris and Brown and in further view of Richard B. Freeman; "Occupational Training In Proprietary Schools and Technical Institutes"; The Review of Economics and Statistics, Vol. 56, No. 3 (Aug. 1974), pp. 310-318 (hereinafter "Freeman").

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VII. Argument

A. Claims 1-47

> 1. The Rejections Under 35 U.S.C. 103(a) Based On Lawlis In View Of Mamoukaris And In Further View of Brown Must Be Reversed Because The Cited References Do Not Teach The Claimed Subject Matter As Alleged

"All words in a claim must be considered in judging the patentability of that claim against the prior art." M.P.E.P. § 2143.03 (quoting *In re Wilson*, 424 F.2d 1382, 1385 (CCPA 1970)). As a consequence, when determining whether a claim is obvious, an examiner must make "a searching comparison of the claimed invention – *including all its limitations* – with the teaching of the prior art." In re Ochiai, 71 F.3d 1565, 1572 (Fed. Cir. 1995) (emphasis added). That is, "obviousness requires a suggestion of all limitations in a claim." CFMT, Inc. v. Yieldup Intern. Corp., 349 F.3d 1333, 1342 (Fed. Cir. 2003) (citing In re Royka, 490 F.2d 981, 985 (CCPA 1974)). Moreover, as the Supreme Court has stated, *"there must be some articulated reasoning* with some rational underpinning to support the legal conclusion of obviousness." KSR Int'l v. Teleflex Inc., 127 S. Ct. 1727, 1741 (2007) (quoting In re Kahn, 441 F.3d 977, 988 (Fed. Cir. 2006) (emphasis added)).

a. Brief Summary Of The Lawlis Reference

Lawlis discusses a manual process for evaluation of software, specifically commercial off the shelf (COTS) Software Products to automate tasks. Lawlis, p. 58, col. 1, ¶ 1. The so-called "requirements driven COTS product evaluation process (RCPEP)" is a manual software evaluation process based on "user defined requirements." Lawlis, p. 58, col. 1, ¶¶ 2 and 3. More particularly, the software evaluation disclosed by Lawlis is based upon required software capabilities. Lawlis, FIG. 2, left-hand column; p. 59, col. 2. Software is evaluated as providing "full coverage," "partial coverage" or "no coverage," and weighting factors are applied to a

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numerical value corresponding to full coverage or partial coverage. For example, "requirements receive a 1 for full coverage, 1/2 for partial coverage, and zero for no coverage." Lawlis, p. 59, col. 1. After either a vendor, user or analyst determines whether a software requirement is provided for in "full coverage" or "partial coverage," the table shown in Lawlis FIG. 2 is created. Lawlis, p. 60, FIG. 2. The analyst then manually adds a column for weights and translates the indicators into numerical values for computation. Lawlis p. 60, FIG. 2.

Lawlis also describes a case study wherein the RCPEP process was applied to evaluating a "COTS product supporting training evaluation [for incorporation] into [a] component based Technical Training Management System" (TTMS) for the Air Force. Lawlis, p. 61, col. 1. In accordance with the manual process, the evaluation began with a trade study wherein questionnaires were used to obtain data on whether the software products met the Air Force requirements. It is important to note that this evaluation was based on the software itself, and whether the software met the *technical requirements* needed to incorporate the software into the Air Force TTMS system.

b.   Brief Summary Of The Mamoukaris Reference

Mamoukaris is directed to the "review of five popular Web-Based Education Tools" (Mamoukaris, p. 2, first paragraph) according to various "comparison criteria" concerning features of the education products themselves (Mamoukaris , p. 3-5, Section III).

c.   Brief Summary Of The Brown Reference

Brown is directed to an examination of "which employees learn from computer-based training that allows a high degree of learner control." Brown, p. 288. To this end, standard

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scoring techniques are employed to determine how well a given student performed in light of the training. Brown, p. 282, under "Knowledge" heading.

>   **d.   The cited references fail to teach the claimed limitation of "business goal rule data representing a business organization's goals with respect to employee training"**

With regard to, for example, claim 5, Appellant respectfully submits that the combination of Lawlis in view of Mamoukaris and in further view of Brown does not teach "business goal rule data representing a business organization's goals with respect to employee training." As admitted by the Office in the Appealed Office Action (p. 5), Lawlis does not teach this limitation.[1] However, again with reference to claim 5, the Office goes on to make alternative statements with regard to this limitation. First, the Office asserts, in taking Official Notice, "that it is old and well known in the art for business organization[s] to have goals with respect to training." Appealed Office Action, p. 5. Subsequently, the Office asserts that Brown teaches this limitation. Appealed Office Action, pp. 7-8.

With regard to the assertion "that it is old and well known in the art for business organization[s] to have goals with respect to training," Appellants note that, even accepting as true the assertion that it is well known for business organizations to have goals with respect to training, this assertion misses the point. More specifically, the limitation in question actually reads "business goal rule *data representing* a business organization's goals with respect to employee training." (emphasis added) Simply put, it appears the Office has taken Official Notice of an abstract concept of "goals" rather than the more concrete formulation of data

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[1] Appellants further note the Office's further admission that "Lawlis and Mamoukaris do not teach the intended use limitation of where the business goal rule data corresponds to a business organization's goals with respect to employee training." Appealed Office Action, p. 7.

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representative of such goals. This distinction is significant when one appreciates that the techniques described and claimed by the instant application are possible, in part, precisely because such goals are reduced to such a data representation; the mere existence of goals in the abstract (even if "old and well known") cannot meet the requirements of the claimed subject matter. In this light, Appellants respectfully submit that the Official Notice noted by the Office fails to remedy the deficiency of Lawlis.

With regard to the assertion that Brown teaches this limitation, the Office alleges, citing page 282 of Brown, that "Brown suggests using a standard scoring approach . . . to evaluate employee learning (i.e., business goal rule data corresponds to a business organization's goals.)" In this instance, it appears that paraphrasing of the actual claim language has lead to the erroneous conclusion that Brown teaches the claimed limitation. Specifically, as noted above, the cited portion of Brown concerns a scoring technique for assessing how well students had learned and were able to apply the course material. That is, the "standard scoring approach" taught by Brown is relevant to a *student's performance* in view of training, but is otherwise not related to anything "representing a *business organization's goals* with respect to employee training," as presently claimed. That the alleged scoring technique taught by the combination of Lawlis in view of Mamoukaris is a standard one or that Brown teaches a standard scoring approach for assessing student performance simply does not rise to a demonstration that any of the references, either alone or in combination, contemplates the use of "business goal rule data representing a business organization's goals with respect to employee training" when those words are given their ordinary meaning commensurate with the instant specification. See, M.P.E.P. § 2111.01. For this reason, Appellants respectfully submit that the application of the

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teachings of Brown to the combination of Lawlis in view of Mamoukaris fails to establish prima facie obviousness of, for example, claim 5.

As demonstrated above, the combination of Lawlis in view of Mamoukaris and in further view of Brown fails to teach each and every limitation of the independent claims and, by extension, their respective dependent claims. Appellants respectfully submit that the various other references cited by the Office (Murphy, Howard, Freeman) fail to overcome the shortcomings of the combination of Lawlis in view of Mamoukaris and in further view of Brown. For this reason, those claims rejected on the basis of these further references are also in suitable condition for allowance.

> 2. Failure To Consider The "Business Goal Rule Data Representing . . . Goals With Respect To Employee Training" Limitation On The Basis Of The Printed Matter Doctrine Was Erroneous

Appellants have noted the Office's continued assertion that the claimed "business goal rule data representing a business organization's goals with respect to employee training" constitutes "descriptive material [that] will not distinguish the prior art in terms of patentability", citing M.P.E.P. § 2106 and two precedents cited therein, specifically *In re Gulack*, 703 F.2d 1381, 217 USPQ 401 (Fed. Cir. 1983) and *In re Lowry*, 32 F.3d 1579, 32 USPQ.2d 1031 (Fed. Cir. 1994). (Appealed Office Action, p. 5) In so doing, it appears that the Office Action is drawing an equivalence between the claimed "business goal rule data representing a business organization's goals with respect to employee training" and so-called "printed matter".

In response, Applicants first note that the discussion of "printed matter" in M.P.E.P. § 2106 as well as the *Gulack* and *Lowry* decisions address the use of printed matter in apparatus claims, particularly whether limitations encompassing printed matter may be properly considered when assessing patentability of apparatus claims. Both *Gulak* and *Lowry* reject the view that

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categorization of a limitation as "printed matter" is sufficient to disregard such limitation, but rather that such limitations will not be given "patentable weight . . . absent a new and unobvious functional relationship between the printed matter and the substrate." *Lowry*, 32 F.3d at 1582, 32 USPQ.2d at 1034.

In particular, the court in *Gulack* found that digits printed on a continuous band should be considered for purposes of patentability. *Gulack*, 703 F.2d at 1387, 217 USPQ at 405. More relevant to the instant application, the court in *Lowry* rejected the notion that the "printer matter" rejections may be applied to claim limitations that include "information stored in a memory", noting that "printed matter cases have no factual relevance where 'the invention as defined by the claims requires that the information be processed not by the mind but by a machine, the computer.'" *Lowry*, 32 F.3d at 1583, 32 USPQ.2d at 1034 (quoting *In re Bernhart*, 417 F.2d 1395, 1399, 163 USPQ 611, 615 (CCPA 1969)). In the instant application, claim 5, for example, recites that the claimed business goal rule data is stored in memory and that the claimed method is implemented by a computer. As such, Applicants respectfully submit that the reliance of the Office Action on "printed matter" grounds is improper and that the presently-claimed "business goal rule data representing a business organization's goals with respect to employee training" must be considered. Even if one were to somehow construe the business goal rule data as printed matter, the presently claimed business goal rule data clearly presents at least as much "patentable weight" as the printed digits found sufficient in *Gulack* when one considers that the business goal rule data is intimately tied to the processing set forth in instant claims.

3.   <u>Ignoring Limitations In The Claims As Mere "Labels" And Arguing Similarity In "Functionality" Between The Claims And Cited References Is Erroneous</u>

In the Appealed Office Action (pp. 2-3), the Office states that:

[T]he examiner showed how the business goal rules function in the same way to assign scores based on thresholds being met (e.g. both the applicant's specification and Lawlis show using a range, and if an evaluation is within a particular range, then a resulting score is given). The mere fact that the "business goal rule data" as argued by the applicants "represents a business organization's goals with respect to employee training" indicates that the business goal rules are being used in a way that is not patentably distinct - i.e. merely to indicate thresholds in how evaluations are scored. The thresholds and resulting scores represent an organization's goals with respect to employee training. In this sense the applicant's invention and Lawlis, as noted previously, **work exactly the same way**. The use of criteria for setting a threshold for applying scores is the same - the labels of the thresholds, i.e. "business goal" rules, does not distinguish the rules over the prior art because **the functionality is the same**. (emphasis added)

In essence, the Office is arguing that the inventions operate according to the same principles and that the particular data operated upon is ineffectual to differentiate the claimed subject matter and the teachings of the prior art. Were Appellants claims attempting to encompass the broad principles as taught by the prior art without further express limitations, there could be no arguing that Appellants' claims are somehow patentable. However, that is not the case here. In this case, Appellants have specifically limited their claims to operate on the basis of a particular type of data, and such limitations must be accounted for in the determination of patentability.

Appellants are unaware of any legal authority for the proposition that prima facie obviousness is demonstrated where the cited references allegedly show the same "functionality" as the claims. Rather, obviousness can only be predicated on a showing that *all limitations* of the claims have been considered. (See, M.P.E.P. § 2143.03: "All words in a claim must be considered in judging the patentability of that claim against the prior art." (citation omitted)) That is, the "functionality" of a claim cannot replace the limitations set forth by the actual language of the claim. See, e.g., *Warner-Jenkinson Co., Inc. v. Hilton Davis Chemical Co.*, 520

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U.S. 17, 41 (1997) ("Each element contained in a patent claim is deemed material to defining the scope of the patented invention . . . .")   Where the Office asserts that "the labels of the thresholds, i.e., 'business goal rules', does not distinguish the rules over the prior art because the functionality is the same," the Office appears to be relying on an alleged showing of equivalence of "functionality" as a proxy (or worse, substitute) for the actual claim language.   As noted above, however, it is not proper for the Office to simply ignore the express language of the claims; the alleged "labels" recited in the claim have to be accorded some meaning.   Indeed, the simple characterizations of limitations in a claim as nonfunctional descriptive material, intended use limitations or "labels" in order to ignore them in favor of a "functionality" basis for rejecting claims is improper and constitutes clear error.

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VIII. Conclusion

For the reasons advanced above, Appellants submit that the Examiner erred in rejecting pending claims 1-47 and respectfully request reversal of the decision of the Examiner.

Respectfully submitted,

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1.   An educational product evaluation method implemented by a computer, the method comprising:

storing business goal rule data in memory of the computer, the business goal rule data representing a business organization's goals with respect to employee training;

analyzing, by the computer, an educational product, wherein an education product includes an instructor led face-to-face course, a self-study course or a virtual course, based on the stored business goal rule data; and

displaying, on a display associated with the computer, an education product summary indicating an alignment of said educational product to said business organization's goals with respect to employee training.

2.   The method of claim 1 wherein analyzing the educational product and displaying an education product summary indicating an alignment of said educational product to said business organization's goals with respect to employee training includes generating at least one educational product alignment value, for indicating the alignment of said educational product to said business organization's goals with respect to employee training, for the educational product based on plurality of educational product evaluation category values and the stored business goal rule data.

3.   The method of claim 1 wherein storing the business goal rule data includes storing data representing rules defined for a plurality of desired business goals wherein the business goal rule data represents data used to determine how the educational product measures

against at least one of: a strategic importance level, a cost effectiveness level and an educational product impact level.

4.   The method of claim 1 including presenting the educational product alignment value for a user.

5.   An educational product evaluation method implemented by a computer, the method comprising:

storing business goal rule data in memory of the computer, the business goal rule data representing a business organization's goals with respect to employee training;

generating, by the computer, a plurality of educational product alignment values representing the alignment of each educational product to said business organization's goals with respect to employee training for each of a plurality of educational products based on a plurality of associated plurality of educational product evaluation category values and the stored business goal rule data, wherein an educational product evaluation category value represents at least one of tuition, duration, participant rating or a priority of course with a content area;

generating, by the computer for each educational product of interest, an overall business alignment value based on the plurality of educational product alignment values; and

generating, by the computer, an educational product summary containing at least the overall business alignment value for each of the plurality of educational products, wherein said plurality of educational products includes at least one of an instructor led face-to-face course, a self-study course or a virtual course.

APPENDIX A

6.   The method of claim 5 wherein storing the business goal rule data includes storing data representing rules defined for a plurality of desired business goals wherein the business goal rule data represents at least one of: a strategic importance level, a cost effectiveness level and an educational product impact level.

7.   The method of claim 5 including generating the educational product summary to contain the plurality of educational product alignment values corresponding to each of the plurality of educational products.

8.   The method of claim 7 including presenting the educational product summary for a user.

9.   The method of claim 5 including generating the plurality of educational product alignment values for each of a plurality of educational products based on received weighting values associated with each of the plurality of educational product alignment values.

10.   The method of claim 5 wherein generating the plurality of educational product alignment values for each of a plurality of educational products includes generating a strategic importance alignment value, a cost effectiveness alignment value and an educational product impact alignment value.

11.   The method of claim 10 wherein the strategic importance alignment value is based on a strategic importance priority level data of an educational content area and on at least

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course hours for the educational products associated with the educational content area; the cost effectiveness alignment value is based on at least a number of hours per educational product and a cost of the educational product; and the educational product impact alignment value is based on at least participant rating data and usage data associated with the educational product.

12. The method of claim 11 including presenting a content area importance table that visually differentiates each strategic importance priority level data for each educational content area.

13. The method of claim 5 wherein storing the business goal rule data includes providing a cost threshold input interface operative to receive cost thresholds for different types of educational products.

14. The method of claim 5 wherein storing the business goal rule data includes providing an educational product time input interface operative to receive time threshold data for different types of educational products.

15. The method of claim 10 including generating a cost effectiveness alignment value matrix containing at least description data relating to different cost scores and different corresponding time scores.

16.   The method of claim 7 including generating the education product summary to include corresponding description data for each educational product and for each educational product alignment value for each educational product.

17.   The method of claim 5 including generating an overall business alignment value range graphic element containing sub ranges corresponding to different degrees of alignment with corresponding business goal rule data.

18.   The method of claim 5 including generating a graphic element illustrating educational product penetration compared to a group of educational products.

19.   The method of claim 5 including generating an educational product content redundancy map indicating which educational products include subject matter that is pertinent to multiple strategic subject categories.

20.   The method of claim 10 wherein generating the educational product summary includes providing a graphic element representing the educational product summary including visual coding of the strategic importance alignment value, the cost effectiveness alignment value and the educational product impact alignment value.

21.   An educational product evaluation method implemented by a computer, the method comprising:

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storing business goal rule data in memory of the computer, the business goal rule data representing a business organization's goals with respect to employee training;

generating, by the computer for each of a plurality of educational products, a plurality of educational product alignment values indicating the alignment of each educational product to said business organization's goals with respect to employee training, wherein the educational products include educational courses including at least one of an instructor led face-to-face course, a self-study course or a virtual course, based on a plurality of associated plurality of educational product evaluation category values and the stored business goal rule data;

storing each of the plurality of educational product alignment values in the memory of the computer;

generating, by the computer for each educational product of interest, an overall business alignment value based on the plurality of stored educational product alignment values;

generating, by the computer, an educational product summary containing at least the overall business alignment value for each of the plurality of educational products and the plurality of stored educational product alignment values that include: a strategic importance alignment value, a cost effectiveness alignment value and an educational product impact alignment value; and

wherein the strategic importance alignment value is based on strategic importance priority level data of an educational content area and on at least course hours for the educational products associated with the educational content area; the cost effectiveness alignment value is based on at least a number of hours per educational product and a cost of the educational product; and the educational product impact alignment value is based on at least participant rating data and usage data associated with the educational products.

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22.   The method of claim 21 including presenting a content area importance table that visually differentiates each strategic importance priority level data for each educational content area.

23.   The method of claim 22 wherein storing the business goal rule data includes providing a cost threshold input interface operative to receive cost thresholds for different types of educational products.

24.   The method of claim 23 wherein storing the business goal rule data includes providing an educational product time input interface operative to receive time threshold data for different types of educational products.

25.   The method of claim 24 including generating a cost effectiveness alignment value matrix containing at least description data relating to different cost scores and different corresponding time scores.

26.   The method of claim 25 including generating the education product summary to include corresponding description data for each educational product and for each educational product alignment value for each educational product.

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27.   The method of claim 21 including generating an overall business alignment value range graphic element containing sub ranges corresponding to different degrees of alignment with corresponding business goal rule data.

28.   The method of claim 21 including generating a graphic element illustrating educational product penetration compared to a group of educational products.

29.   The method of claim 21 including generating an educational product content redundancy map indicating which educational products include subject matter that is pertinent to multiple strategic subject categories.

30.   The method of claim 21 wherein generating the educational product summary includes providing a graphic element representing the educational product summary including visual coding the strategic importance alignment value, the cost effectiveness alignment value and the educational product impact alignment value.

31.   An educational product evaluation apparatus comprising:
at least one processing device; and
memory containing executable instructions that when executed by the at least one processing device, causes the at least one processing device to:
store business goal rule data, the business goal rule data representing a business organization's goals with respect to employee training; and

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generate at least one educational product alignment value for an educational product based on a plurality of educational product evaluation category values and the stored business goal rule data, wherein said at least one educational product alignment value indicates the alignment of said educational product to said business organization's goals with respect to employee training, wherein said educational product evaluation category values represent at least one of tuition, duration, participant rating or a priority of course with a content area, wherein said educational product is one of an instructor led face-to-face course, a self-study course or a virtual course.

32. The apparatus of claim 31 wherein the stored business goal rule data represents rules defined for a plurality of desired business goals wherein the business goal rule data represents data used to determine how the educational product measures against at least one of: a strategic importance level, a cost effectiveness level and an educational product impact level.

33. The apparatus of claim 31 including a display operatively coupled to the at least one processing device, and wherein the at least one processing device controls presentation of the educational product alignment value on the display for a user.

34. An educational product evaluation apparatus comprising:

at least one processing device; and

memory containing executable instructions that when executed by the at least one processing device, causes the at least one processing device to:

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store business goal rule data, the business goal rule data representing a business organization's goals with respect to employee training, and provide a source of a plurality of educational product evaluation category values;

generate a plurality of educational product alignment values representing the alignment of each educational product to said business organization's goals with respect to employee training for each of a plurality of educational products based on an associated plurality of educational product evaluation category values obtained from the plurality of educational product evaluation category values source and the stored business goal rule data, wherein an educational product evaluation category value represents at least one of tuition, duration, participant rating or a priority of course with a content area; and

generate, for each educational product of interest, an overall business alignment value based on the plurality of educational product alignment values; and to generate an educational product summary containing at least the overall business alignment value for each of the plurality of educational products values that include: a strategic importance alignment value, a cost effectiveness alignment value and an educational product impact alignment value; and

wherein the strategic importance alignment value is based on a strategic importance priority level data of an educational content area and on at least course hours for the educational products associated with the educational content area; the cost effectiveness alignment value is based on at least a number of hours per educational product and a cost of the educational product; and the educational product impact alignment value is based on at least participant rating data and usage data associated with the educational product, wherein said plurality of educational products includes at least one of an instructor led face-to-face course, a self-study course or a virtual course.

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35.   The apparatus of claim 34 wherein the memory includes executable instructions that cause one or more processing devices to present a content area importance table that visually differentiates each strategic importance priority level data for each educational content area.

36.   The apparatus of claim 34 wherein the memory includes executable instructions that cause one or more processing devices to provide a cost threshold input interface operative to receive cost thresholds for different types of educational products.

37.   The apparatus of claim 34 wherein the memory includes executable instructions that cause one or more processing devices to provide an educational product time input interface operative to receive time threshold data for different types of educational products.

38.   The apparatus of claim 34 wherein the memory includes executable instructions that cause one or more processing devices to generate a cost effectiveness alignment value matrix containing at least description data relating to different cost scores and different corresponding time scores.

39.   A storage medium comprising:

memory containing executable instructions that when executed by the at least one processing device, causes the at least one processing device to:

store business goal rule data, the business goal rule data representing a business organization's goals with respect to employee training, and provide a plurality of educational product evaluation category values;

generate a plurality of educational product alignment values representing the alignment of each educational product to said business organization's goals with respect to employee training for each of a plurality of educational products based on a plurality of associated plurality of educational product evaluation category values obtained from the plurality of educational product evaluation category values source and the stored business goal rule data, , wherein an educational product evaluation category value represents at least one of tuition, duration, participant rating or a priority of course with a content area; and

generate, for each educational product of interest, an overall business alignment value based on the plurality of educational product alignment values; and to generate an educational product summary containing at least the overall business alignment value for each of the plurality of educational products values that include: a strategic importance alignment value, a cost effectiveness alignment value and an educational product impact alignment value; and

wherein the strategic importance alignment value is based on strategic importance priority level data of an educational content area and on at least course hours for the educational products associated with the educational content area; the cost effectiveness alignment value is based on at least a number of hours per educational product and a cost of the educational product; and the educational product impact alignment value is based on at least participant rating data and usage data associated with the educational, wherein said plurality of educational products includes at least one of an instructor led face-to-face course, a self-study course or a virtual course.

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40. The storage medium of claim 39 wherein the memory includes executable instructions that cause one or more processing devices to present a content area importance table that visually differentiates each strategic importance priority level data for each educational content area.

41. The storage medium of claim 39 wherein the memory includes executable instructions that cause one or more processing devices to provide a cost threshold input interface operative to receive cost thresholds for different types of educational products.

42. The storage medium of claim 39 wherein the memory includes executable instructions that cause one or more processing devices to provide an educational product time input interface operative to receive time threshold data for different types of educational products.

43. An educational product evaluation apparatus comprising:

memory containing business goal rule data;

an educational product analyzer, operatively coupled to the memory, and further comprising:

a strategic importance generator operative to generate a strategic importance alignment value based on a plurality of associated strategic alignment category values and the business goal rule data, the business goal rule data representing a business organization's goals

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with respect to employee training and wherein an educational product is at least one of an instructor led face-to-face course, a self-study course or a virtual course;

a cost effectiveness generator operative to generate a cost effectiveness alignment value based on associated cost effectiveness category values and based on the business goal rule data;

an educational product impact generator operative to generate an educational product impact alignment value based on a plurality of associated educational product impact category values and based on the stored business goal rule data;

an overall business alignment generator operatively coupled to the strategic importance generator, the cost effectiveness generator and the educational product impact generator, and operative to generate, on a per educational product basis, an overall business alignment value based on the strategic importance alignment value, the cost effectiveness alignment value and the educational product impact alignment value; and

a multi-educational product summary generator, operatively coupled to the overall business alignment generator, and operative to generate an educational product summary containing at least the overall business alignment value for each of a plurality of educational products of interest and the strategic importance alignment value, the cost effectiveness alignment value and the educational product impact alignment value.

44.   The apparatus of claim 43 wherein the educational product summary contains visually coded representations of the strategic importance alignment value, the cost effectiveness alignment value and the educational product impact alignment value.

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45.   The apparatus of claim 43 wherein the overall business alignment value is generated based on received weighting values associated with each of the cost effectiveness alignment value and the educational product impact alignment value.

46.   The apparatus of claim 43 wherein the educational product summary contains, for each educational product of interest, corresponding description data describing a level of each associated strategic importance alignment value, cost effectiveness alignment value and educational product impact alignment value.

47.   The educational product educational method of claim 5, wherein said business goal rule data includes at least a course duration limitation limiting the number of days a week an employee can participate in a course given required job related activities.

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EVIDENCE APPENDIX

[NONE]

RELATED PROCEEDINGS

[NONE]

APPENDIX C